REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 2, 6, 7, 11, 14-32, 39, 40, 43, 47-50, and 54 have been canceled. Claim 1, 3, 8-10, 33-38, 41, 42, 44, 51-53, and 55 are amended. Claims 1, 3-5, 8-10, 12, 13, 33-38, 41, 42, 44-46, 51-53, 55, and 56 are pending. Support for the amendments to the claims can be found throughout the specification and also in previously considered dependent claims. For example, claim 2 is incorporated into claim 1, subject matter from claim 36 is incorporated into claim 33, and claims 47 and 48 are incorporated into claim 44.

Accordingly, since the subject matter of the amendments to the claims has been previously considered, the amendments should be entered without requiring a new search.

Examiner Interview

Applicant's attorney William J. Breen, III (Reg. No. 45,313) discussed the state of the application with Examiner Kim over the telephone on 12/04/2009. Specifically, an agreement was reached that the amendments made in the previous office action response to overcome the §101 rejection, if made in this response, would be entered without requiring a new search. The Examiner also indicated that such amendments would be sufficient to overcome the §101 rejection (*see also Office Action*, p.2). Accordingly, appropriate amendments have been made herein.

Disposition of The Claims

The Office states that "these rejections are directed to the disposition of the claims as filed on 11/24/09" (*Office Action*, p.2). However, no claims have been filed on any such date. Therefore, the rejections cannot be directed to any such claims. Since the amendments filed on 10/13/09 were not entered by the Office, Applicant assumes that the claims filed on 4/23/09 are currently pending. Accordingly, the above listing of claims above is based on the claims filed on 4/13/09 and replaces all previous listings.

§101 Rejection

Claims 33-43 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter (*Office Action*, p.3). However, the Office acknowledges that the previous amendments to claims 33-38, 41, and 42, filed on 10/13/09 but not entered, would be sufficient to overcome the §101 rejection (*Office Action*, p.2). Accordingly, the Applicant respectfully submits that the §101 rejection be withdrawn.

§102 Rejections

Claims 1, 2, 4, 8, 10, 13, 33, 34, 36, 38, 42, 44, 45, 47, 51, 53, and 56 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,094,676 to Gray et al (hereinafter "Gray").

Claims 1-5, 8-10, 12, 13, 33-38, 41, 42, 44-48, 51-53, 55, and 56 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,301,609 to Aravamudan et al (hereinafter "Aravamudan").

Claim 38 is rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,124,435 to Fernando et al. (*Office Action*, p.4). However, U.S. Patent No. 7,124,435 is not issued to Fernando, but is instead issued to Phillipe Richard. Applicant's attorney, Brittan A. Glad, contacted the Examiner to discuss this discrepancy. The Examiner agreed that Fernando, as cited, is the same Fernando reference that was cited in the previous office action; namely, U.S. Patent No. 7,386,878 to Fernando et al. (hereinafter "Fernando").

The Applicant respectfully disagrees with the rejections for the following reasons.

Claim 1 as amended recites a method comprising [emphasis added]:

determining by a discovery machine whether a first user associated with a first client machine will accept a communication initiated by a second user associated with a second client machine, wherein said first and second users are registered with said discovery machine;

if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established, said direct link is configured such that said communication is not delivered through said discovery machine and *said direct link is closed after said communication is delivered*, and wherein no direct link is established if said first user will not accept said communication.

Subject matter from claim 2 has been incorporated into this claim. Gray does not show or disclose "establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established, said direct link is configured such that said communication is not delivered through said discovery machine and *said direct link is closed after said communication is delivered*," as recited in claim 1 (emphasis added). Gray only describes that the channel can be disconnected at the completion of a communication *session* to minimize transaction costs associated with accessing the network channel (*Gray*, col. 5, lines 40-43). Gray describes such communication session as a conversation, exchange of files, participation in real-time gaming, or any other peer-to-peer activity (*Gray*, col. 5, lines 38-40). In contrast to Gray's communication session, claim 1 recites, in relevant part, "*a communication* initiated by a second user" and wherein "said direct link is closed after *said communication* is delivered." There is no disclosure or suggestion whatsoever in Gray of any such feature.

In addition, Gray does not show or disclose "determining by a discovery machine whether a first user associated with a first client machine will accept a communication by a second user associated with a second client machine," as recited in claim 1. Gray only describes that "the originating unit *assumes* that the message has been received and that there is a willingness to establish a connection" and that "the receiving unit *infers* from the message the originating unit's willingness to establish a connection" (*Gray*, col. 5, lines 4-8). Gray's assumption and or inference of a willingness to establish a connection is not the same as "determining by a discovery machine whether a first user associated with

a first client machine will accept a communication by a second user associated with a second client machine," as recited in claim 1. Accordingly, Gray does not show or disclose each and every element of claim 1 and none of the other submitted references, alone or in combination with Gray, correct this defect.

For example, Aravamudan does not show or disclose "establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established, said direct link is configured such that said communication is not delivered through said discovery machine and *said direct link is closed after said communication is delivered*," as recited in claim 1 (emphasis added). In the rejection of claim 2, the Office does not provide any citation within Aravamudan to support the rejection. Instead, the Office states that Aravamudan discloses this feature "by virtue of the fact that the communication *session* terminates" (*Office Action*, p.9). Applicant respectfully submits that, as described above, a session is not equivalent to "said communication" as recited in claim 1. Additionally, there is no disclosure or suggestion whatsoever in Aravamudan to indicate that "said direct link is closed after said communication is delivered," as recited in claim 1.

In addition, the Office asserts that Aravamudan discloses "establishing a direct link between said first client machine and said second client machine to deliver said communication" (*Office Action*, p.8). Applicant respectfully disagrees. Specifically, Aravamudan describes that "[n]otification of the CPE device on which the user is currently registered online may also be forwarded to the buddy, to aid the buddy in determining the appropriate time, means, and method for contacting the user should such action be desired" (*Aravamudan*, col.

10, lines 62-66). However, Applicant cannot locate any disclosure or suggestion in Aravamudan that indicates "establishing a direct link," as recited in claim 1. Therefore, Aravamudan does not show or disclose each and every element of claim 1.

Accordingly, claim 1 is allowable and withdrawal the rejection is respectfully requested.

Claims 2-5, 8-10, 12, and 13 depend either directly or indirectly from claim 1 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based at least on the same rationale discussed with respect to claim 1. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejections is respectfully requested.

Claim 33 as amended recites an article of manufacture including a computer-readable medium having instructions stored thereon that, responsive to execution by a discovery machine, cause the discovery machine to perform operations comprising [emphasis added]:

> determining whether a first user associated with a first client machine will accept a communication initiated by a second user associated with a second client machine, the first and second users being registered with said discovery machine;

> if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine in order to deliver said communication such that said communication is not

delivered through said discovery machine, wherein no direct link is established if said first user will not accept said communication; and

> *responsive to delivery of said communication, establishing a new direct link between said second client machine and said first client machine to communicate an additional communication.*

Subject matter from dependent claim 36 has been incorporated into this claim. Applicant respectfully submits that Gray does not show or disclose "*responsive to delivery of said communication, establishing a new direct link between said second client machine and said first client machine to communicate an additional communication that is related to the communication,*" as recited in claim 33. For reasons similar to those described above, Applicant respectfully submits that a *session*, as described by Gray and asserted by the Office to be described by Aravamudan, is not equivalent to "a communication," as recited in claim 33. Therefore, the references of record do not show or disclose "*responsive to delivery of said communication, establishing a new direct link between said second client machine and said first client machine to communicate an additional communication that is related to the communication,*" as recited in claim 33.

Accordingly, claim 33 is allowable and withdrawal of the rejection is respectfully requested.

Claims 34-38, 41, and 42 depend either directly or indirectly from claim 33 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based at least on the same rationale discussed with respect to claim 33. These claims are also allowable for their own recited

features which, in combination with those recited in claim 33, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejections is respectfully requested.

Claim 38 depends from claim 33. The Office asserts that Fernando discloses "instant messaging applications provide updateable contract lists" (*Office Action*, p.5). Applicant respectfully disagrees. As cited by the Office, Fernando describes an instant messaging server in the excerpt below:

> In one example, the server is an instant messaging server, and the peer devices each include an instant messaging client for communicating with the instant messaging server over the authenticated connections. (*Fernando*, col. 4, lines 20-23).

Contrary to the Office's assertion, however, the above excerpt does not provide support for the Office's rejection. Furthermore, Applicant cannot locate any disclosure or suggestion whatsoever in Fernando that indicates "wherein at least one of said first client machine or said second client machine maintains a plurality of contact information," as recited in claim 38. Accordingly, claim 38 is not anticipated by Fernando and withdrawal of the rejection is respectfully requested.

Claim 44 as amended recites one or more servers comprising a discovery machine configured to [emphasis added]:

> determine whether a first user associated with a first client machine will accept a communication initiated by a second user associated with a second client machine, said first and second users being registered with said discovery machine;

if said first user will accept said communication, establish a direct link between said first client machine and said second client machine in order to deliver said communication wherein if said direct link is established, said communication is not delivered through said discovery machine and wherein no direct link is established if said first user will not accept said communication;

establish a new direct link between said second client machine and said first client machine to communicate an additional communication; and

prefix a thread of related previous communications to said additional communication.

Subject matter from claims 47 and 48 has been incorporated into this claim. Applicant respectfully submits that, based on similar reasoning to that described above, neither Gray nor Aravamudan disclose a feature to "establish a new direct link between said second client machine and said first client machine to communicate an additional communication," as recited in claim 44.

Additionally, Aravamudan fails to disclose a feature to "prefix a thread of related previous communications to said additional communication," as recited in claim 44. In the rejection of claim 48, the Office asserts that Aravamudan describes that "IM services and e-mail services store and display prior communications" (*Office Action*, p.9). However, the Office does not cite to any location in the reference to support such assertion. Further, Applicant cannot locate any disclosure or suggestion in Aravamudan that indicates any such feature. Therefore, Aravamudan fails to disclose each and every element of claim 44 as amended.

Accordingly, claim 44 is allowable and withdrawal of the rejection is respectfully requested.

Claims 45-48, 51-53, 55, and 56 depend either directly or indirectly from claim 44 and are allowable as depending from an allowable base claim. Each of the dependent claims is allowable based at least on the same rationale discussed with respect to claim 44. These claims are also allowable for their own recited features which, in combination with those recited in claim 44, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejections is respectfully requested.

Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant respectfully requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 1/15/10   By: /Brittan A. Glad/
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